

claims 6, 24-27, 29-30, and 39 were rejected under the judicially created doctrine of provisional obviousness-type double patenting as being unpatentable over claims 1-2, 15-17, 20-21, 24-25, and 27 of copending application No. 09/337,253 in view of U.S. Patent No. 5,758,355 to Buchanan. Claims 4-10 and 15-45 were rejected under the judicially created doctrine of provisional obviousness-type double patenting as being unpatentable over claims 11-38 of copending application No. 9/610,696, divisional application of the above-referenced application. Applicants will address the provisional obviousness-type double patenting rejections once the pending rejections to the claims are resolved.

REJECTION UNDER 35 U.S.C. § 103:

In the Office Action, at page 22, claims 4-10, 16-30, 40-44, and 46 were rejected under 35 U.S.C. § 103 in view of U.S. Patent No. 6,038,366 to Ohno et al. ("Ohno") in view of U.S. Patent No. 5,758,355 to Buchanan ("Buchanan"). This rejection is traversed and reconsideration is requested.

The Office Action correctly recognized that Ohno fails to teach or suggest "wherein the manufacturer information comprises an identification information of a manufacturer of a recording apparatus that recorded or modified the content of the recording medium different from the identification information prior to the recording or the modification," as recited in independent claim 4. Accordingly, the Office Action relies on Buchanan as teaching such a claimed feature.

Buchanan generally describes a server including a plurality of tables, which is accessible on a server computer system. See abstract. The server includes storage media encoded with the server database. See column 4, lines 22-26. According to Buchanan, company records, for example, may indicate not only which companies are associated with a particular team, but also may identify records in a contact table that specify the contact persons at the company. See column 2, lines 33-37. The Contact Table of Buchanan includes contact id., first name, last name, company id., row id., modify date, and modify employee. See column 8, lines 40-50. However, similarly to Ohno, Buchanan fails to teach or suggest "manufacturer information to support a manufacturer's specific function, wherein the manufacturer information comprises an **identification information of a manufacturer of a recording apparatus**," emphasis added, as recited in independent claim 4. Rather, the Contact Table appears to merely list employees of different companies modifying a company's records. There is no teaching or suggestion in Buchanan that the Contact Table stores "identification information of a

manufacturer of a recording apparatus,” as recited in independent claim 4. The identification information includes employees modifying records that are related to a team for which an associated remote employee is included. See column 7, lines 47-52. Furthermore, Buchanan fails to teach or suggest “wherein the manufacturer information comprises an identification information of a manufacturer of a recording apparatus **that recorded or modified the content of the recording medium different from the identification information prior to the recording or the modification,**” emphasis added, as recited in independent claim 4.

Accordingly, Buchanan and Ohno, individually or combined, fail to teach or suggest all the claimed features of independent claim 4 and related dependent claims. It is respectfully asserted that independent claims 1 and related dependent claims are allowable in view of the prior art of record.

Without adequate support from Ohno and/or Buchanan of a need or motivation to achieve an efficient system operation in Ohno, the Office Action indicates that “it would have been obvious to one of ordinary skill in the art at the time of the invention to the identification as taught by Buchanan into Ohno's system in order to achieve efficient system operation in Ohno by allowing user to know who modif[ied] the content of record.” Rather than using the teachings of the cited references, the Office Action combines the references by disregarding current case law regarding the standard of an obviousness rejection under 35 U.S.C. § 103.

It is improper to merely deem something obvious without any teaching/suggestion from the cited references. As applied to the determination of patentability when the issue is obviousness, “it is fundamental that rejections under 35 U.S.C. §103 must be based on evidence comprehended by the language of that section.” See In re Lee, 61 USPQ2d 1430 (Fed. Cir. 2002), (citing In re Grasselli, 713 F.2d 731, 739, 218 USPQ 769, 775 (Fed. Cir. 1983)). The essential factual evidence on the issue of obviousness is set forth in Graham v. John Deere Co., 383 U.S. 1, 17-18, 148 USPQ 459, 467 (1966) and extensive ensuing precedent. The patent examination process centers on prior art and the analysis thereof. When patentability turns on the question of obviousness, the search for and analysis of the prior art includes evidence relevant to the finding of whether there is a teaching, motivation, or suggestion to select and combine the references relied on as evidence of obviousness. See In re Lee, 61 USPQ2d 1430 (CA FC 2002), (citing McGinley v. Franklin Sports, Inc., 262 F.3d 1339, 1351-52, 60 USPQ2d 1001, 1008 (Fed. Cir. 2001) (“The central question is whether there is reason to combine [the] references,” a question of fact drawing on the Graham factors). Accordingly, evidence must be provided from the prior art of some teaching, motivation, or

suggestion to select and combine the references.

Thus, as pointed out in In re Lee, the record must support motivation, i.e., there must be something in the record pointing out where the recited motivation can be found. In addition, there must be some discussion on how that purported motivation or suggestion is even relevant to the reference being modified.

It is the Applicants' position that only the present invention sets forth all the claimed features, as well as the motivation for combining the same. The outstanding rejection would appear to have taken the teachings of the present invention and applied the same to generate a combination of Ohno and Buchanan as set forth in the Office Action.

In view of the foregoing, it is respectfully requested that independent claim 4 and related dependent claims be allowed. Furthermore, the Office Action refers to similar portions of the cited references to reject independent claims 7, 8, 10, and 28 as the portions of the cited references previously discussed and distinguished from the claimed features of independent claim 4. The arguments presented above supporting the patentability of independent claim 4 in view of Ohno and/or Buchanan are incorporated herein to support the patentability of independent claims 7, 8, 10, and 28. Accordingly, Ohno and/or Buchanan, individually or combined, fail to teach or suggest all the claimed features of independent claims 4, 7, 8, 10, and 28. It is respectfully requested that independent claims 4, 7, 8, 10, and 28 and related dependent claims be allowed.

In the Office Action, at page 29, claims 15, 31-39, and 45 were rejected under Ohno in view of Buchanan and further in view of U.S. Patent No. to Yokota ("Yokota"). This rejection is traversed and reconsideration is requested.

Independent claim 31 recites, "a reproducer to make a first determination of the manufacturer of the apparatus that recorded or modified the content based upon the read manufacturer identification information different from the manufacturer identification information prior to the recording or the modification." The Office Action refers to similar portions of the cited references to reject independent claim 31 as the portions of the cited references previously discussed and distinguished from the claimed features of independent claim 4. The descriptions of Ohno and Buchanan provided above and the arguments presented above supporting the patentability of independent claim 4, for instance, are incorporated herein to support the patentability of independent claim 31.

Yokota generally describes a recording medium including a recording area, a first

managing data area and a second managing area. See abstract. In the recording area are recorded only audio data, or an intermixture of audio data and video data. However, similar to Ohno and Buchanan, Yokota is silent as to providing "a reproducer to make a first determination of the manufacturer of the apparatus that recorded or modified the content based upon the read manufacturer identification information different from the manufacturer identification information prior to the recording or the modification," as recited in independent claim 31. Rather, Yokota generally describes managing areas where managing data is recorded for controlling a recording or reproducing operation of audio data for the recording area when only the audio data is recorded in or reproduced from the recording area or when both of audio data and video data are recorded in or reproduced from the recording area. See column 2, lines 9-18. Yokota fails to teach or suggest all the claimed features of independent claim 31.

Accordingly, Ohno, Buchanan, and/or Yokota, individually or combined, fail to teach or suggest all the claimed features of independent claim 31. It is respectfully requested that independent claim 31 and related dependent claims be allowed.

CONCLUSION:

In accordance with the foregoing, it is respectfully submitted that all outstanding objections and rejections have been overcome and/or rendered moot, and further, that all pending claims patentably distinguish over the prior art. Thus, there being no further outstanding objections or rejections, the application is submitted as being in condition for allowance, which action is earnestly solicited.

If the Examiner has any remaining issues to be addressed, it is believed that prosecution can be expedited by the Examiner contacting the undersigned attorney for a telephone interview to discuss resolution of such issues.

Serial No. 09/610,380

If there are any underpayments or overpayments of fees associated with the filing of this Amendment, please charge and/or credit the same to our Deposit Account No. 19-3935.

Respectfully submitted,

STAAS & HALSEY LLP

Date: February 11, 2003

By: Alicia Choi
Alicia M. Choi
Registration No. 46,621

700 Eleventh Street, NW, Suite 500
Washington, D.C. 20001
(202) 434-1500